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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/321,360 05/27/99 GUHEEN

M AND1P101

EXAMINER

TM02/0507

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ROBINSON BOYCE A
ART UNIT PAPER NUMBER

2163
DATE MAILED:

7
05/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

GM

Office Action Summary

Application No.

09/321,360

Applicant(s)

Guheen, et al.

Examiner

Akiba Robinson-Boyce

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 27, 1999
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4,5,6 20) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

An evaluation of these steps does not show that the method performs independent physical acts. The step of “displaying a pictorial representation of an existing system including a plurality of components”, or “presenting a first set of components that are to be delivered in a first phase by indicia coding the same”, or “presenting a second set of components that are to be delivered in a second phase by indicia coding the same in a manner unique with respect to the indicia coding of the first set of components” are not sufficient to meet the requirements of physical acts, because they are grounded in the abstract idea of physically performing manipulations of data. Moreover, none of the method steps affirmatively recite physical transformation occurring within a computer. In this regard, the claims merely manipulate an abstract algorithm without any limitation to a practical limitation within the technological arts.

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Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4, 5, 7, 10, 11, 13, 16, 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rassman, et al (US Patent 4,937,743).

As per claims 1, 7, 13, Rassman, et al discloses:

displaying a pictorial representation of an existing system...(Col. 2, lines 59-65, Col. 14, lines 13-16, Fig. 7, [resources 123, 233, 224]);

presenting a first set of components...(Col. 15, lines 41-43, Fig. 7, [phase one]);

presenting a second set of components...(Col. 15, lines 41-43, Fig. 7, [phase two]);

The following is inherent with Rassman, et al's system because since he teaches that his method is carried out in a computer system, computer programs using code segments and logic is absolutely necessary for the computer to successfully process information and produce results:

A computer program...

a code segment...

logic...

As per claims 2, 8, 14, Rassman, et al discloses:

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wherein a legend is presented which defines the indicia coding...(Col. 7, lines 11-18, Col. 8, lines 5-7 [indicia is being used to define an item]).

As per claims 4, 10, 16 Rassman, et al discloses:

wherein the components of the existing system are selected from the group of components including...customer-related services...(Col. 4, lines 36-42, Col. 5, lines 51-53, [hospital services are customer-related where the patient is the customer]).

As per claims 5, 11, 17, Rassman, et al discloses:

wherein the indicia coding is selected from the group of indicia coding including texture coding, color coding...(Col. 6, lines 11-5).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 6, 9, 12, 15, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rassman, et al (US Patent 4,937,743) as applied to claims 1, 7 and 13 above, and further in view of Turnbull (US Patent 5,208,765).

As per claims 3, 9, 15, Rassman, et al fails to teach the following, however Turnbull discloses:

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wherein the components of the existing system are selected from the group of components including...operation services and developer services...(Col. 2, lines 27-30).

It would have been obvious to one of ordinary skill in the art to select the components of the system from the group of components including...operation services and developer services because in order to fulfill services, the delivery of components or resources are necessary.

As per claims 6, 12, 18, Rassman, et al fails to teach the following, however Turnbull discloses:

wherein the existing system is a web...(Col. 2, lines 39-43, [wide area network]).

It would have been obvious to one of ordinary skill in the art for the existing system to be a web architecture framework because these types of networks are commonly used in order to deliver information to a wide variety of people.

Conclusion

7. An inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba Robinson-Boyce whose telephone number is (703) 305-1340. The examiner can normally be reached on Monday-Friday from 6:30 AM-3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3988.

An inquiry of a general nature or relating to the status of this application proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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Akiba Robinson-Boyce

Patent Examiner

Group Art Unit 2163

May 3, 2001



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SUPERVISORY PATENT EXAMINER
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